



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/832,340

04/10/2001

Ilya Schiller

19965-004001

9977

26161 7590 11/29/2007
FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

LE, BRIAN Q

ART UNIT

PAPER NUMBER

2624

MAIL DATE

DELIVERY MODE

11/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/832,340

Applicant(s)

SCHILLER ET AL.

Examiner

Brian Q. Le

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10,12,13,38-54 and 59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-10, 12-13, 38-54 and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/02/07.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

Response to Amendment and Arguments

1. Applicant's amendment filed October 02, 2007, has been entered and made of record.
2. The rejection of claims 1-2, 4-10, 12-13, and 38-54 under 35 U.S.C. 112, first paragraph is withdrawn.
3. Applicant's arguments, see Remarks, filed October 02, 2007, with respect to the rejection(s) of claim(s) 1, 12, 13, and 49 under 35 U.S.C. 103 rejections have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Schiller et al. U.S. Patent No. 6,577,299.

Information Disclosure Statement

4. The information disclosure statement filed 10/02/2007 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because a copy of the translation is required if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c) (see 37 CFR 1.98). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-10, 12-13, 38-51 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamakita, Tooru EP 0 865 192 and Schiller et al. U.S. Patent No. 6,577,299.

Regarding claim 1, Yamakita teaches a method comprising:

Receiving handwriting data (writing data on portable terminal) electronically from a remote user at a handwritten-information server (host device) (page 1, column 1), and
Processing the handwriting data in accordance with instructions (page 1, column 2, lines 30-34) provided through a user interface (FIG. 1, element 1) of the mobile communication device (page 1, column 2). However, Yamakita does not explicitly teach a receiving, at a mobile communication device representing handwriting motion captured electronically on a handwriting-capturing device separate from the mobile communication device. Schiller teaches a method of processing handwriting (FIG. 4, element 480) wherein a mobile communication device (cellular phone) (column 12, lines 5-10) representing handwriting motion captured electronically (cellular phone displays handwriting) (column 12, lines 15-18) on a handwriting-capturing device (column 12, lines 9-12) separate from the mobile communication device (the pen and the cellular phone are separate because they communicate with each other by a

communication systems such as infrared) (column 12, lines 1-23). Modifying Yamakita's method of processing handwriting according to Schiller would be able to provide a receiving, at a mobile communication device that is different from the mobile communication device. This would improve processing because this would further provide a wireless communication between devices such as pen and cellular phones and thus capture writing of user efficiently (column 2, lines 20-30) and therefore, it would have been obvious to one of the ordinary skill in the art to modify Yamakita according to Schiller.

For claim 2, Yamakita further teaches the method which the handwriting data is generated by the handwriting device (portable terminal such as table for special pen/stylus) (page 1, column 1 and FIG. 2).

Regarding claim 4, Yamakita discloses method including performing handwriting recognition at the site of the remote user (page 1, column 2, first 2 lines).

For claim 5, Yamakita teaches the method including performing handwriting recognition at the mobile communication device (character recognition at personal computer/host device) (column 1, lines 33-38).

For claim 7, Yamakita teaches the method which the handwriting data includes information identifying a destination of the handwriting data (page 2, column 2, lines 30-39).

Referring to claim 8, Yamakita further teaches the method which the processing of the handwriting data includes forwarding it to a destination (page 2, column 2, lines 30-39).

Also to claim 9, Yamakita teaches the method which the forwarding comprises sending the handwriting data in FAX format (page 8, column 13, lines 25-30).

Regarding claim 10, Yamakita teaches the method which the forwarding comprises sending the handwriting data as an email attachment or in a body of an email (content of a email) (column 2, lines 40-50).

For claim 12, please refer back to claim 1 for discussed limitations and claim 6 for the teaching of wireless communication. In addition, Yamakita teaches the concept of storing (computer) (page 2, column 1, line 30).

Referring to claim 13, please refer back to claims 1 for the discussed limitations and claims 6 and 12 for the teaching of wireless communication. Furthermore, Yamakita teaches a method providing an interactive user interface on a screen of a mobile device to enable a user to control functions (commands) applied (page 7, column 11, lines 39-47) to the stored handwriting information (simple interface) (page 2, column 2, lines 40-45).

Regarding claim 38, Yamakita teaches the method in which enabling the user includes receiving input through one or more of a screen on the mobile device, a web browser, speech recognition, or touch-tone sequences (a fax has touch-tone sequences) (page 3, column 3, line 41).

For claim 39, Yamakita teaches the method in which receiving input includes receiving additional handwriting information (special pen provides additional handwriting information) (page 2, column 2, lines 45-55)

Referring to claim 40, Yamakita teaches the method in which the functions include includes converting the handwriting information to a character format (page 2, column 2, lines 35-38).

As to claim 41, Yamakita teaches the method in which the functions include retrieving the handwritten information (page 3, column 3, lines 3-7).

For claim 42, Yamakita teaches the method in which the functions include forwarding the handwritten information to another user (send by email) (page 3, column 3, line 41).

Referring to claim 43, Yamakita teaches the method in which the functions include making the handwritten information available on the Internet (page 4, column 6, lines 25-30).

For claim 44, Yamakita teaches the method in which the functions include perform computations on the handwritten information (handwritten image analysis) (page 8, column 13, lines 45-50).

Regarding claim 45, Yamakita teaches the method in which the functions include interpreting the handwritten information into computer-usable information (converting the handwriting information to a character format to be understood by computer) (page 2, column 2, lines 35-38).

For claim 46, Yamakita teaches the method in which interpreting the handwritten information includes extracting an address from the handwritten information (column 3, lines 33-38 and column 6, lines 55-58).

Regarding claim 47, Yamakita teaches the method in which interpreting the handwritten information extracting a phone number from the handwritten information (Yamakita provides the ability to extract image data; thus will be able to extract phone number if there is phone number contained in the image data) (column 6, lines 20-23).

7. Claims 6, 49-51 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamakita, Tooru EP 0 865 192 and Schiller et al. U.S. Patent No. 6,577,299 as applied to claim 1, and further in view of Lee U.S. Patent No. 5,347,477.

For claim 6, Yamakita teaches the method of including at the handwriting-capturing device, forming an electronic file representing the handwritten information (column 1, lines 13-17), and transmitting the electronically captured handwriting from the communication device to the handwritten-information server (page 1, column 1 and column 2). Yamakita does not explicitly teach wherein the pen can be electronic wireless pen. Lee further teaches a method processes handwriting wherein handwriting data is generated by an electronic wireless communication device (wireless pen) (column 3, lines 24-25 and FIG. 5). Modifying Yamakita's method of processing handwriting data according to Lee would be able to provide a wireless pen in providing the wireless capability for the apparatus. This would improve processing and therefore, it would have been obvious to one of the ordinary skill in the art to modify Yamakita according to Lee.

Regarding claim 49, please refer back to claims 1, 6 and 12 for further teachings and explanations. In addition, Yamakita teaches processing the handwriting data represented by the file in accordance with instructions provided to the server by the user (column 8, lines 25-30 and column 16, lines 31-37).

For claim 48, Yamakita teaches the method in which interpreting the handwritten information includes extracting a task from the handwritten information (column 3, lines 33-38 and column 6, lines 55-58).

For claim 50, Yamakita further teaches the method which the second mobile communication device (portable terminal) (column 2, lines 50-55) comprises a user interface and is enabled to display a graphical representation (personal computer display) (column 2, lines 1-3) of the handwriting motion data and to edit the handwriting motion data (column 12, lines 23-31).

Regarding claim 51, Yamakita teaches the method in which the instructions (communication function) (column 5, lines 5-15) are provided to the mobile communication device (portable terminals) (column 2, lines 50-55) in the handwriting and identified at the mobile communication device (pattern recognition of character) (column 5, lines 30-35).

For claim 53, please refer back to claim 51 for further teachings and explanations.

For claim 59, as discussed in claims 1, 6 and 12, Yamakita also teaches a capability of sending handwriting data in an email on a mobile communication device (page 1). In addition, Schiller further teaches a limitation of transmitting the file wirelessly to a mobile communication device separate from the handwriting-capturing device (the pen and the cellular phone are separate because they communicate with each other by a communication systems such as infrared) (column 12, lines 1-23).

8. Claims 52 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamakita, Tooru EP 0 865 192 and Schiller et al. U.S. Patent No. 6,577,299 as applied to claims 1 and 12 above, and further in view of Inamoto U.S. Patent No. 6,236,753.

Regarding claim 52, Yamkita does not explicitly teach the concept of hand-capturing device is a penholder used in combination with a pen. Morishita (FIG. 5) and Lee (FIG. 1A)

teach a hand-capturing device as a pen. Inamoto teaches a hand-writing processing (abstract) wherein handwriting-capturing device is a pen holder used in combination with a pen (column 5, lines 65-67). Modifying Yamakita's method of processing handwriting data according to Inamoto would be able to use pen holder in combination with a pen so that the pen can be positioned and protected once it is not in used. This would improve processing and therefore, it would have been obvious to one of the ordinary skill in the art to modify Yamakita according to Inamoto.

For claim 54, please refer back to claim 52 for further teachings and explanations.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Q. Le whose telephone number is 571-272-7424. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on 571-272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian Le
Primary Examiner
November 26, 2007